

COPY

1 WILLIAM L. ANTHONY (State Bar No. 106908)
ERIC L. WESENBERG (State Bar No. 139696)
2 MARK R. WEINSTEIN (State Bar No. 193043)
ORRICK, HERRINGTON & SUTCLIFFE, LLP
3 1000 Marsh Road
Menlo Park, CA 94025
4 Telephone: (650) 614-7400
Facsimile: (650) 614-7401
5

6 STEVEN ALEXANDER (admitted *Pro Hac Vice*)
KRISTIN L. CLEVELAND (admitted *Pro Hac Vice*)
7 JAMES E. GERINGER (admitted *Pro Hac Vice*)
JOHN D. VANDENBERG
8 KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
9 121 S.W. Salmon Street
Portland, OR 97204
10 Telephone: (503) 226-7391
Facsimile: (503) 228-9446

11 Attorneys for Defendant and Counterclaimant,
12 MICROSOFT CORPORATION

13 UNITED STATES DISTRICT COURT
14 NORTHERN DISTRICT OF CALIFORNIA
15 OAKLAND DIVISION

16 INTERTRUST TECHNOLOGIES
CORPORATION, a Delaware corporation,
17 Plaintiff,

18 v.

19 MICROSOFT CORPORATION, a
Washington corporation,
20 Defendant.

21 MICROSOFT CORPORATION, a
Washington corporation,
22 Counterclaimant,
23

24 v.

24 INTERTRUST TECHNOLOGIES
CORPORATION, a Delaware corporation,
25 Counterclaim-Defendant.
26

CASE NO. C 01-1640 SBA (MEJ)

**MICROSOFT CORPORATION'S
ANSWER AND COUNTERCLAIMS TO
INTERTRUST'S FOURTH AMENDED
COMPLAINT**

DEMAND FOR JURY TRIAL

1 Defendant Microsoft Corporation ("Microsoft") answers the Fourth Amended
2 Complaint of InterTrust Technologies Corporation ("InterTrust") as follows:

3 1. Microsoft admits that the Fourth Amended Complaint purports to state a
4 cause of action under the patent laws of the United States, 35 United States Code, §§ 271 and
5 281. Microsoft denies that it has infringed or now infringes the patents asserted against Microsoft
6 in the Fourth Amended Complaint. Microsoft denies any and all remaining allegations of
7 paragraph 1 of the Fourth Amended Complaint.

8 2. Microsoft admits that the Fourth Amended Complaint purports to state a
9 cause of action over which this Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and
10 1338(a).

11 3. Microsoft admits, for purposes of this action only, that venue is proper in
12 this judicial district. Microsoft denies any and all remaining allegations of paragraph 3 of the
13 Fourth Amended Complaint.

14 4. On information and belief, Microsoft admits the allegations of paragraph 4
15 of the Fourth Amended Complaint.

16 5. Microsoft admits the allegations of paragraph 5 of the Fourth Amended
17 Complaint.

18 6. Microsoft denies any and all allegations of paragraph 6 of the Fourth
19 Amended Complaint, except that it admits, for purposes of this action only, that it transacts
20 business in this judicial district.

21 7. Microsoft admits that on its face the title page of U.S. Patent No. 6,185,683
22 B1 ("the '683 Patent") states that it was issued February 6, 2001, is entitled "Trusted and secure
23 techniques, systems and methods for item delivery and execution," and lists "InterTrust
24 Technologies Corp." as the assignee. Microsoft denies that the '683 Patent was duly and lawfully
25 issued. Microsoft further denies any and all remaining allegations of paragraph 7 of the Fourth
26 Amended Complaint.

1 8. Microsoft admits that on its face the title page of U.S. Patent No. 6,253,193
2 B1 ("the '193 Patent") states that it was issued June 26, 2001, is entitled "Systems and methods
3 for the secure transaction management and electronic rights protection," and lists "InterTrust
4 Technologies Corporation" as the assignee. Microsoft denies that the '193 Patent was duly and
5 lawfully issued. Microsoft further denies any and all remaining allegations of paragraph 8 of the
6 Fourth Amended Complaint.

7 9. Microsoft admits that on its face the title page of U.S. Patent No. 5,920,861
8 ("the '861 Patent") states that it was issued July 6, 1999, is entitled "Techniques for defining
9 using and manipulating rights management data structures," and lists "InterTrust Technologies
10 Corp." as the assignee. Microsoft denies that the '861 Patent was duly and lawfully issued.
11 Microsoft further denies any and all remaining allegations of paragraph 9 of the Fourth Amended
12 Complaint.

13 10. Microsoft admits that on its face the title page of U.S. Patent No. 5,892,900
14 ("the '900 Patent") states that it was issued April 6, 1999, is entitled "Systems and methods for
15 secure transaction management and electronic rights protection," and lists "InterTrust
16 Technologies Corp." as the assignee. Microsoft denies that the '900 Patent was duly and lawfully
17 issued. Microsoft further denies any and all remaining allegations of paragraph 10 of the Fourth
18 Amended Complaint.

19 11. Microsoft admits that on its face the title page of U.S. Patent No. 5,982,891
20 ("the '891 Patent") states that it was issued November 9, 1999, is entitled "Systems and methods
21 for secure transaction management and electronic rights protection," and lists "InterTrust
22 Technologies Corp." as the assignee. Microsoft denies that the '891 Patent was duly and lawfully
23 issued. Microsoft further denies any and all remaining allegations of paragraph 11 of the Fourth
24 Amended Complaint.

25 12. Microsoft admits that on its face the title page of U.S. Patent No. 5,917,912
26 ("the '912 Patent") states that it was issued June 29, 1999, is entitled "System and methods for
27 secure transaction management and electronic rights protection," and lists "InterTrust
28 Technologies Corp." as the assignee. Microsoft denies that the '912 Patent was duly and lawfully

1 issued. Microsoft further denies any and all remaining allegations of paragraph 12 of the Fourth
2 Amended Complaint.

3 13. Microsoft admits that on its face the title page of U.S. Patent No. 6,157,721
4 ("the '721 Patent") states that it was issued December 5, 2000, is entitled "System and methods
5 using cryptography to protect secure computing environments," and lists "InterTrust
6 Technologies Corp." as the assignee. Microsoft denies that the '721 Patent was duly and lawfully
7 issued. Microsoft further denies any and all remaining allegations of paragraph 13 of the Fourth
8 Amended Complaint.

9 14. Microsoft admits that on its face the title page of U.S. Patent No. 5,915,019
10 ("the '019 Patent") states that it was issued June 22, 1999, is entitled "Systems and methods for
11 secure transaction management and electronic rights protection," and lists "InterTrust
12 Technologies Corp." as the assignee. Microsoft denies that the '019 Patent was duly and lawfully
13 issued. Microsoft further denies any and all remaining allegations of paragraph 14 of the Fourth
14 Amended Complaint.

15 15. Microsoft admits that on its face the title page of U.S. Patent No. 5,949,876
16 ("the '876 Patent") states that it was issued September 7, 1999, is entitled "Systems and methods
17 for secure transaction management and electronic rights protection," and lists "InterTrust
18 Technologies Corp." as the assignee. Microsoft denies that the '876 Patent was duly and lawfully
19 issued. Microsoft further denies any and all remaining allegations of paragraph 15 of the Fourth
20 Amended Complaint.

21 16. Microsoft admits that on its face the title page of U.S. Patent No. 6,112,181
22 ("the '181 Patent") states that it was issued August 29, 2000, is entitled "Systems and methods for
23 matching, selecting, narrowcasting, and/or classifying based on rights management and/or other
24 information," and lists "InterTrust Technologies Corp." as the assignee. Microsoft denies that the
25 '181 Patent was duly and lawfully issued. Microsoft further denies any and all remaining
26 allegations of paragraph 16 of the Fourth Amended Complaint.

27 17. Microsoft admits that on its face the title page of U.S. Patent No. 6,389,402
28 B1 ("the '402 Patent") states that it was issued May 14, 2002, is entitled "Systems and methods

1 for secure transaction management and electronic rights protection,” and lists “InterTrust
2 Technologies Corp.” as the assignee. Microsoft denies that the ‘402 Patent was duly and lawfully
3 issued. Microsoft further denies any and all remaining allegations of paragraph 17 of the Fourth
4 Amended Complaint.

5 18. Microsoft repeats and reasserts its responses to paragraphs 1-7 of the
6 Fourth Amended Complaint, as if fully restated herein.

7 19. Microsoft admits that the Fourth Amended Complaint purports to state a
8 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now
9 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
10 denies any and all remaining allegations of paragraph 19 of the Fourth Amended Complaint.

11 20. Microsoft denies any and all allegations of paragraph 20 of the Fourth
12 Amended Complaint.

13 21. Microsoft denies any and all allegations of paragraph 21 of the Fourth
14 Amended Complaint.

15 22. Microsoft denies any and all allegations of paragraph 22 of the Fourth
16 Amended Complaint.

17 23. Microsoft denies any and all allegations of paragraph 23 of the Fourth
18 Amended Complaint.

19 24. Microsoft denies any and all allegations of paragraph 24 of the Fourth
20 Amended Complaint.

21 25. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 8 of the
22 Fourth Amended Complaint, as if fully restated herein.

23 26. Microsoft admits that the Fourth Amended Complaint purports to state a
24 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now
25 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
26 denies any and all remaining allegations of paragraph 26 of the Fourth Amended Complaint.

27 27. Microsoft denies any and all allegations of paragraph 27 of the Fourth
28 Amended Complaint.

1 28. Microsoft denies any and all allegations of paragraph 28 of the Fourth
2 Amended Complaint.
3 29. Microsoft denies any and all allegations of paragraph 29 of the Fourth
4 Amended Complaint.
5 30. Microsoft denies any and all allegations of paragraph 30 of the Fourth
6 Amended Complaint.
7 31. Microsoft denies any and all allegations of paragraph 31 of the Fourth
8 Amended Complaint.
9 32. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 9 of the
10 Fourth Amended Complaint, as if fully restated herein.
11 33. Microsoft admits that the Fourth Amended Complaint purports to state a
12 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now
13 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
14 denies any and all remaining allegations of paragraph 33 of the Fourth Amended Complaint.
15 34. Microsoft denies any and all allegations of paragraph 34 of the Fourth
16 Amended Complaint.
17 35. Microsoft denies any and all allegations of paragraph 35 of the Fourth
18 Amended Complaint.
19 36. Microsoft denies any and all allegations of paragraph 36 of the Fourth
20 Amended Complaint.
21 37. Microsoft denies any and all allegations of paragraph 37 of the Fourth
22 Amended Complaint.
23 38. Microsoft denies any and all allegations of paragraph 38 of the Fourth
24 Amended Complaint.
25 39. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 10 of
26 the Fourth Amended Complaint, as if fully restated herein.
27 40. Microsoft admits that the Fourth Amended Complaint purports to state a
28 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now

1 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
2 denies any and all remaining allegations of paragraph 40 of the Fourth Amended Complaint.

3 41. Microsoft denies any and all allegations of paragraph 41 of the Fourth
4 Amended Complaint.

5 42. Microsoft denies any and all allegations of paragraph 42 of the Fourth
6 Amended Complaint.

7 43. Microsoft denies any and all allegations of paragraph 43 of the Fourth
8 Amended Complaint.

9 44. Microsoft denies any and all allegations of paragraph 44 of the Fourth
10 Amended Complaint.

11 45. Microsoft denies any and all allegations of paragraph 45 of the Fourth
12 Amended Complaint.

13 46. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 11 of
14 the Fourth Amended Complaint, as if fully restated herein.

15 47. Microsoft admits that the Fourth Amended Complaint purports to state a
16 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now
17 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
18 denies any and all remaining allegations of paragraph 47 of the Fourth Amended Complaint.

19 48. Microsoft denies any and all allegations of paragraph 48 of the Fourth
20 Amended Complaint.

21 49. Microsoft denies any and all allegations of paragraph 49 of the Fourth
22 Amended Complaint.

23 50. Microsoft denies any and all allegations of paragraph 50 of the Fourth
24 Amended Complaint.

25 51. Microsoft denies any and all allegations of paragraph 51 of the Fourth
26 Amended Complaint.

27 52. Microsoft denies any and all allegations of paragraph 52 of the Fourth
28 Amended Complaint.

1 53. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 12 of
2 the Fourth Amended Complaint, as if fully restated herein.

3 54. Microsoft admits that the Fourth Amended Complaint purports to state a
4 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now
5 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
6 denies any and all remaining allegations of paragraph 54 of the Fourth Amended Complaint.

7 55. Microsoft denies any and all allegations of paragraph 55 of the Fourth
8 Amended Complaint.

9 56. Microsoft denies any and all allegations of paragraph 56 of the Fourth
10 Amended Complaint.

11 57. Microsoft denies any and all allegations of paragraph 57 of the Fourth
12 Amended Complaint.

13 58. Microsoft denies any and all allegations of paragraph 58 of the Fourth
14 Amended Complaint.

15 59. Microsoft denies any and all allegations of paragraph 59 of the Fourth
16 Amended Complaint.

17 60. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 13 of
18 the Fourth Amended Complaint, as if fully restated herein.

19 61. Microsoft admits that the Fourth Amended Complaint purports to state a
20 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now
21 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
22 denies any and all remaining allegations of paragraph 61 of the Fourth Amended Complaint.

23 62. Microsoft denies any and all allegations of paragraph 62 of the Fourth
24 Amended Complaint.

25 63. Microsoft denies any and all allegations of paragraph 63 of the Fourth
26 Amended Complaint.

27 64. Microsoft denies any and all allegations of paragraph 64 of the Fourth
28 Amended Complaint.

1 65. Microsoft denies any and all allegations of paragraph 65 of the Fourth
2 Amended Complaint.

3 66. Microsoft denies any and all allegations of paragraph 66 of the Fourth
4 Amended Complaint.

5 67. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 14 of
6 the Fourth Amended Complaint, as if fully restated herein.

7 68. Microsoft admits that the Fourth Amended Complaint purports to state a
8 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now
9 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
10 denies any and all remaining allegations of paragraph 68 of the Fourth Amended Complaint.

11 69. Microsoft denies any and all allegations of paragraph 69 of the Fourth
12 Amended Complaint.

13 70. Microsoft denies any and all allegations of paragraph 70 of the Fourth
14 Amended Complaint.

15 71. Microsoft denies any and all allegations of paragraph 71 of the Fourth
16 Amended Complaint.

17 72. Microsoft denies any and all allegations of paragraph 72 of the Fourth
18 Amended Complaint.

19 73. Microsoft denies any and all allegations of paragraph 73 of the Fourth
20 Amended Complaint.

21 74. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 15 of
22 the Fourth Amended Complaint, as if fully restated herein.

23 75. Microsoft admits that the Fourth Amended Complaint purports to state a
24 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now
25 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
26 denies any and all remaining allegations of paragraph 75 of the Fourth Amended Complaint.

27 76. Microsoft denies any and all allegations of paragraph 76 of the Fourth
28 Amended Complaint.

1 77. Microsoft denies any and all allegations of paragraph 77 of the Fourth
2 Amended Complaint.

3 78. Microsoft denies any and all allegations of paragraph 78 of the Fourth
4 Amended Complaint.

5 79. Microsoft denies any and all allegations of paragraph 79 of the Fourth
6 Amended Complaint.

7 80. Microsoft denies any and all allegations of paragraph 80 of the Fourth
8 Amended Complaint.

9 81. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 16 of
10 the Fourth Amended Complaint, as if fully restated herein.

11 82. Microsoft admits that the Fourth Amended Complaint purports to state a
12 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now
13 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
14 denies any and all remaining allegations of paragraph 82 of the Fourth Amended Complaint.

15 83. Microsoft denies any and all allegations of paragraph 83 of the Fourth
16 Amended Complaint.

17 84. Microsoft denies any and all allegations of paragraph 84 of the Fourth
18 Amended Complaint.

19 85. Microsoft denies any and all allegations of paragraph 85 of the Fourth
20 Amended Complaint.

21 86. Microsoft denies any and all allegations of paragraph 86 of the Fourth
22 Amended Complaint.

23 87. Microsoft denies any and all allegations of paragraph 87 of the Fourth
24 Amended Complaint.

25 88. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 17 of
26 the Fourth Amended Complaint, as if fully restated herein.

27 89. Microsoft admits that the Fourth Amended Complaint purports to state a
28 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now

1 infringes the patents asserted against Microsoft in the Fourth Amended Complaint. Microsoft
2 denies any and all remaining allegations of paragraph 89 of the Fourth Amended Complaint.

3 90. Microsoft denies any and all allegations of paragraph 90 of the Fourth
4 Amended Complaint.

5 91. Microsoft denies any and all allegations of paragraph 91 of the Fourth
6 Amended Complaint.

7 92. Microsoft denies any and all allegations of paragraph 92 of the Fourth
8 Amended Complaint.

9 93. Microsoft denies any and all allegations of paragraph 93 of the Fourth
10 Amended Complaint.

11 94. Microsoft denies any and all allegations of paragraph 94 of the Fourth
12 Amended Complaint.

13 **AFFIRMATIVE AND OTHER DEFENSES**

14 Further answering the Fourth Amended Complaint, Microsoft asserts the following
15 defenses. Microsoft reserves the right to amend its answer with additional defenses as further
16 information is obtained.

17 **First Defense: Noninfringement of the Asserted Patents**

18 95. Microsoft has not infringed, contributed to the infringement of, or induced
19 the infringement of U.S. Patent No. 6,185,683 B1 ("the '683 Patent"), U.S. Patent No. 6,253,193
20 B1 ("the '193 Patent"), U.S. Patent No. 5,920,861 ("the '861 Patent"), U.S. Patent No. 5,892,900
21 ("the '900 Patent"), U.S. Patent No. 5,982,891 ("the '891 Patent"), U.S. Patent No. 5,917,912
22 ("the '912 Patent"), U.S. Patent No. 6,157,721 ("the '721 Patent"), U.S. Patent No. 5,915,019
23 ("the '019 Patent"), U.S. Patent No. 5,949,876 ("the '876 Patent"), U.S. Patent No. 6,112,181
24 ("the '181 Patent"), or U.S. Patent No. 6,389,402 B1 ("the '402 Patent") and is not liable for
25 infringement thereof.

26 96. Any and all Microsoft products or methods that are accused of
27 infringement have substantial uses that do not infringe and therefore cannot induce or contribute
28 to the infringement of the '683 Patent, the '193 Patent, the '861 Patent, the '900 Patent, the '891

1 Patent, the '912 Patent, the '721 Patent, the '019 Patent, the '876 Patent, the '181 Patent, or the
2 '402 Patent.

3 **Second Defense: Invalidity of the Asserted Patents**

4 97. On information and belief, the '683 Patent, the '193 Patent, the '861
5 Patent, the '900 Patent, the '891 Patent, the '912 Patent, the '721 Patent, the '019 Patent, the '876
6 Patent, the '181 Patent, and the '402 Patent are invalid for failing to comply with the provisions
7 of the Patent Laws, Title 35 U.S.C., including without limitation one or more of 35 U.S.C. §§
8 102, 103 and 112.

9 **Third Defense: Unavailability of Relief**

10 98. On information and belief, Plaintiff has failed to plead and meet the
11 requirements of 35 U.S.C. § 271(b) and (c) and is not entitled to any alleged damages prior to
12 providing any actual notice to Microsoft of the '683 Patent, the '193 Patent, the '861 Patent, the
13 '900 Patent, the '891 Patent, the '912 Patent, the '721 Patent, the '019 Patent, the '876 Patent, the
14 '181 Patent, or the '402 Patent.

15 **Fourth Defense: Unavailability of Relief**

16 99. On information and belief, Plaintiff has failed to plead and meet the
17 requirements of 35 U.S.C. § 284 for enhanced damages and is not entitled to any damages prior to
18 providing any actual notice to Microsoft of the '683 Patent, the '193 Patent, the '861 Patent, the
19 '900 Patent, the '891 Patent, the '912 Patent, the '721 Patent, the '019 Patent, the '876 Patent, the
20 '181 Patent, and/or the '402 Patent and any alleged infringement thereof.

21 **Fifth Defense: Unavailability of Relief**

22 100. On information and belief, Plaintiff has failed to plead and meet the
23 requirements of 35 U.S.C. § 287, and has otherwise failed to show that it is entitled to any
24 damages.

25 **Sixth Defense: Prosecution History Estoppel**

26 101. Plaintiff's alleged causes of action for patent infringement are barred under
27 the doctrine of prosecution history estoppel, and Plaintiff is estopped from claiming that the '683
28 Patent, the '193 Patent, the '861 Patent, the '900 Patent, the '891 Patent, the '912 Patent, the '721

1 Patent, the '019 Patent, the '876 Patent, the '181 Patent, and/or the '402 Patent covers or includes
2 any accused Microsoft product or method.

3 **Seventh Defense: Dedication to the Public**

4 102. Plaintiff has dedicated to the public all methods, apparatus, and products
5 disclosed in the '683 Patent, the '193 Patent, the '861 Patent, the '900 Patent, the '891 Patent, the
6 '912 Patent, the '721 Patent, the '019 Patent, the '876 Patent, the '181 Patent, and/or the '402
7 Patent but not literally claimed therein, and is estopped from claiming infringement by any such
8 public domain methods, apparatus, and products.

9 **Eighth Defense: Use/Manufacture By/For United States Government**

10 103. To the extent that any accused product has been used or manufactured by
11 or for the United States, Plaintiff's claims and demands for relief are barred by 28 U.S.C. § 1498.

12 **Ninth Defense: License**

13 104. To the extent that any of Plaintiff's allegations of infringement are
14 premised on the alleged use, sale, offer for sale, license or offer of license of products that were
15 manufactured by or for a licensee of InterTrust and/or provided by or to Microsoft by or to a
16 licensee of InterTrust, such allegations are barred pursuant to license.

17 **Tenth Defense: Acquiescence**

18 105. Plaintiff has acquiesced in at least a substantial part of the Microsoft
19 conduct alleged to infringe.

20 **Eleventh Defense: Laches**

21 106. Plaintiff's claims for relief are barred, in whole or in part, by the equitable
22 doctrine of laches.

23 **Twelfth Defense: Inequitable Conduct**

24 107. The '861 Patent claims are unenforceable due to inequitable conduct,
25 including those acts and failures to act set forth in Microsoft's Counterclaim for Declaratory
26 Judgment of Unenforceability of the '861 Patent, set forth below.

1 **Thirteenth Defense: Inequitable Conduct**

2 108. The '900 Patent claims are unenforceable due to inequitable conduct,
3 including those acts and failures to act set forth in Microsoft's Counterclaim for Declaratory
4 Judgment of Unenforceability of the '900 Patent, set forth below.

5 **Fourteenth Defense: Inequitable Conduct**

6 109. The '721 Patent claims are unenforceable due to inequitable conduct,
7 including those acts and failures to act set forth in Microsoft's Counterclaim for Declaratory
8 Judgment of Unenforceability of the '721 Patent, set forth below.

9 **Fifteenth Defense: Inequitable Conduct**

10 110. The '181 Patent claims are unenforceable due to inequitable conduct,
11 including those acts and failures to act set forth in Microsoft's Counterclaim for Declaratory
12 Judgment of Unenforceability of the '181 Patent, set forth below.

13 **Sixteenth Defense: Unenforceability**

14 111. The claims of the '891 Patent, the '912 Patent, the '861 Patent, the '683
15 Patent, the '193 Patent, the '900 Patent, the '721 Patent, the '019 Patent, the '876 Patent, the '181
16 Patent, and the '402 Patent are unenforceable due to unclean hands, inequitable conduct and
17 misuse and illegal extension of the patent right, including those acts and failures to act set forth in
18 Count XVIII of Microsoft's Counterclaims, set forth below.

19 **Seventeenth Defense: Waiver**

20 112. InterTrust has waived any accusations against Microsoft not made in the
21 InterTrust's Amended Disclosures of Asserted Claims served October 29, 2002, including in
22 particular any "draft" accusations referred to in Court October 22, 2002, that were not included in
23 those Amended Disclosures.
24
25
26
27
28

COUNTERCLAIMS

COUNT I - DECLARATORY
JUDGMENT OF NONINFRINGEMENT

1
2
3
4 1. This action arises under the patent laws of the United States, Title 35
5 U.S.C. §§ 1, et seq. This Court has subject matter jurisdiction over this counterclaim under 28
6 U.S.C. §§ 1338, 2201, and 2202.

7 2. Microsoft Corporation ("Microsoft") is a Washington corporation with its
8 principal place of business in Redmond, Washington.

9 3. On information and belief, Plaintiff /Counterclaim Defendant InterTrust
10 Technologies Corporation ("InterTrust") is a Delaware corporation with its principal place of
11 business in Santa Clara, California.

12 4. InterTrust purports to be the owner of U.S. Patent Nos. 6,185,683 B1 ("the
13 '683 Patent"), 6,253,193 B1 ("the '193 Patent"), 5,940,504 ("the '504 Patent"), 5,920,861 ("the
14 '861 Patent"), U.S. Patent No. 5,892,900 ("the '900 Patent"), U.S. Patent No. 5,982,891 ("the
15 '891 Patent"), U.S. Patent No. 5,917,912 ("the '912 Patent"), U.S. Patent No. 6,157,721 ("the
16 '721 Patent"), U.S. Patent No. 5,915,019 ("the '019 Patent"), U.S. Patent No. 5,949,876 ("the
17 '876 Patent"), U.S. Patent No. 6,112,181 ("the '181 Patent"), and U.S. Patent No. 6,389,402 B1
18 ("the '402 Patent").

19 5. InterTrust alleges that Microsoft has infringed the '683 Patent, the '193
20 Patent, the '861 Patent, the '900 Patent, the '891 Patent, the '912 Patent, the '721 Patent, the '019
21 Patent, the '876 Patent, the '181 Patent, and the '402 Patent. InterTrust previously alleged that
22 Microsoft has infringed the '504 Patent. InterTrust now concedes that the previously accused
23 Microsoft conduct and products do not infringe any claim of the '504 Patent. No Microsoft
24 product accused in this lawsuit infringes any claim of the '504 Patent.

25 6. No Microsoft product has infringed, either directly or indirectly, any claim
26 of the '683 Patent, the '193 Patent, the '504 Patent, the '861 Patent, the '900 Patent, the '891
27 Patent, the '912 Patent, the '721 Patent, the '019 Patent, the '876 Patent, the '181 Patent, or the
28 '402 Patent, and Microsoft is not liable for infringement thereof.

1 7. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
2 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to the
3 infringement or noninfringement of the '683 Patent, the '193 Patent, the '861 Patent, the '900
4 Patent, the '891 Patent, the '912 Patent, the '721 Patent, the '019 Patent, the '876 Patent, the '181
5 Patent, and the '402 Patent. If InterTrust does not concede noninfringement of the '504 Patent,
6 then such an actual controversy also exists for the '504 Patent.

7 **COUNT II - DECLARATORY**
8 **JUDGMENT OF INVALIDITY OF THE '683 PATENT**

9 8. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims, as if
10 fully restated here.

11 9. The '683 Patent, and each claim thereof, is invalid for failing to comply
12 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

13 10. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
14 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
15 whether the claims of the '683 Patent are valid or invalid.

16 **COUNT III - DECLARATORY**
17 **JUDGMENT OF INVALIDITY OF THE '193 PATENT**

18 11. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if
19 fully restated here.

20 12. The '193 Patent, and each claim thereof, is invalid for failing to comply
21 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

22 13. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
23 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
24 whether the claims of the '193 Patent are valid or invalid.

25 **COUNT IV - DECLARATORY**
26 **JUDGMENT OF INVALIDITY OF THE '504 PATENT**

27 14. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if
28 fully restated here.

1 15. The '504 Patent, and each claim thereof, is invalid for failing to comply
2 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

3 16. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
4 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
5 whether the claims of the '504 Patent are valid or invalid.

6 **COUNT V - DECLARATORY**
7 **JUDGMENT OF INVALIDITY OF THE '861 PATENT**

8 17. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if
9 fully restated here.

10 18. The '861 Patent, and each claim thereof, is invalid for failing to comply
11 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

12 19. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
13 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
14 whether the claims of the '861 Patent are valid or invalid.

15 **COUNT VI - DECLARATORY**
16 **JUDGMENT OF INVALIDITY OF THE '900 PATENT**

17 20. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if
18 fully restated here.

19 21. The '900 Patent, and each claim thereof, is invalid for failing to comply
20 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

21 22. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
22 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
23 whether the claims of the '900 Patent are valid or invalid.

24 **COUNT VII - DECLARATORY**
25 **JUDGMENT OF INVALIDITY OF THE '891 PATENT**

26 23. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if
27 fully restated here.
28

1 24. The '891 Patent, and each claim thereof, is invalid for failing to comply
2 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

3 25. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
4 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
5 whether the claims of the '891 Patent are valid or invalid.
6

7 **COUNT VIII - DECLARATORY**
8 **JUDGMENT OF INVALIDITY OF THE '912 PATENT**

9 26. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if
10 fully restated here.

11 27. The '912 Patent, and each claim thereof, is invalid for failing to comply
12 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

13 28. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
14 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
15 whether the claims of the '912 Patent are valid or invalid.

16 **COUNT IX - DECLARATORY**
17 **JUDGMENT OF INVALIDITY OF THE '721 PATENT**

18 29. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if
19 fully restated here.

20 30. The '721 Patent, and each claim thereof, is invalid for failing to comply
21 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

22 31. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
23 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
24 whether the claims of the '721 Patent are valid or invalid.

25 **COUNT X - DECLARATORY**
26 **JUDGMENT OF INVALIDITY OF THE '019 PATENT**

27 32. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if
28 fully restated here.

1 33. The '019 Patent, and each claim thereof, is invalid for failing to comply
2 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

3 34. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
4 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
5 whether the claims of the '019 Patent are valid or invalid.
6

7 **COUNT XI - DECLARATORY**
8 **JUDGMENT OF INVALIDITY OF THE '876 PATENT**

9 35. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if
10 fully restated here.

11 36. The '876 Patent, and each claim thereof, is invalid for failing to comply
12 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

13 37. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
14 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
15 whether the claims of the '876 Patent are valid or invalid.
16

17 **COUNT XII - DECLARATORY**
18 **JUDGMENT OF INVALIDITY OF THE '181 PATENT**

19 38. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if
20 fully restated here.

21 39. The '181 Patent, and each claim thereof, is invalid for failing to comply
22 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

23 40. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
24 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
25 whether the claims of the '181 Patent are valid or invalid.
26
27
28

**COUNT XIII - DECLARATORY
JUDGMENT OF INVALIDITY OF THE '402 PATENT**

41. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if fully restated here.

42. The '402 Patent, and each claim thereof, is invalid for failing to comply with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

43. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202, exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to whether the claims of the '402 Patent are valid or invalid.

**COUNT XIV - DECLARATORY JUDGMENT
OF UNENFORCEABILITY OF THE '861 PATENT**

44. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims, as if fully restated here.

45. Claims 1-129 of the '861 Patent application (SN 08/805,804), and claims 1-101 of the '861 Patent, were not and are not entitled to the benefit of any application filing date prior to February 25, 1997, under 35 U.S.C. § 120 or otherwise.

46. On information and belief, an article entitled "DigiBox: A Self-Protecting Container for Information Commerce" (hereinafter "the Sibert article") was published in the United States in July 1995. A copy of the Sibert article has been produced bearing bates numbers MSI022935-MSI022947.

47. "Exhibit A" refers to the document attached as Exhibit A to Microsoft's counterclaims filed in response to InterTrust's Second Amended Complaint (namely, a reprint of an article entitled "DigiBox: A Self-Protecting Container for Information Commerce"). On information and belief, the content of pages 2-14 of Exhibit A was presented at a public conference in the United States in July 1995.

48. "Exhibit B" refers to the document attached as Exhibit B to Microsoft's counterclaims filed in response to InterTrust's Second Amended Complaint (namely, a copy of a

1 page from an International Application published under the Patent Cooperation Treaty (PCT),
2 bearing International Publication Number WO 96/27155 hereinafter (hereafter "the WO 96/27155
3 (PCT) publication").

4 49. On information and belief, the WO 96/27155 (PCT) publication has, at all
5 times since its filing date, been owned and controlled by InterTrust or its predecessors in interest.

6 50. The WO 96/27155 (PCT) publication was published on September 6, 1996.

7 51. United States Patent No. 5,910,987 ("the '987 Patent") issued on June 8,
8 1999, from a continuation of an application filed on February 13, 1995.

9 52. The Sibert article is prior art to claims 1-129 of the '861 Patent application
10 (SN 08/805,804).

11 53. The Sibert article is prior art to claims 1-101 of the '861 Patent under 35
12 U.S.C. § 102(b).

13 54. The WO 96/27155 (PCT) publication is prior art to claims 1-129 of the
14 '861 Patent application (SN 08/805,804).

15 55. The WO 96/27155 (PCT) publication is prior art to claims 1-101 of the
16 '861 Patent under 35 U.S.C. § 102(a).

17 56. The '987 Patent is prior art to claims 29-129 of the '861 Patent application
18 (SN 08/805,804).

19 57. The '987 Patent is prior art to claims 1-101 of the '861 Patent, under 35
20 U.S.C. § 102(e).

21 58. The Sibert article was material to the patentability of claim 1 of the '861
22 Patent application (SN 08/805,804).

23 59. The Sibert article was material to the patentability of claims 2-129 of the
24 '861 Patent application (SN 08/805,804).

25 60. The WO 96/27155 (PCT) publication was material to the patentability of
26 claim 1 of the '861 Patent application (SN 08/805,804).

27 61. The WO 96/27155 (PCT) publication was material to the patentability of
28 claims 2-129 of the '861 Patent application (SN 08/805,804).

1 62. The '987 Patent was material to the patentability of claims 29-129 of the
2 '861 Patent application (SN 08/805,804).

3 63. One or more of the '861 Patent applicants knew, while the '861 Patent
4 application (SN 08/805,804) was pending, of the July 1995 publication of the Sibert article.

5 64. On information and belief, one or more of the '861 Patent applicants knew,
6 while the '861 Patent application (SN 08/805,804) was pending, of the September 1996
7 publication of the WO 96/27155 (PCT) publication.

8 65. On information and belief, one or more of the '861 Patent applicants knew,
9 while the '861 Patent application (SN 08/805,804) was pending, of the June 8, 1999 issuance of
10 the '987 Patent.

11 66. On information and belief, one or more of the attorneys who prosecuted or
12 assisted in prosecuting the '861 Patent application (SN 08/805,804) knew, while that application
13 was pending, of the July 1995 publication of the Sibert article.

14 67. One or more of the attorneys who prosecuted or assisted in prosecuting the
15 '861 Patent application (SN 08/805,804) knew, while that application was pending, of the
16 September 1996 publication of the WO 96/27155 (PCT) publication.

17 68. One or more of the attorneys who prosecuted or assisted in prosecuting the
18 '861 Patent application (SN 08/805,804) knew, while that application was pending, of the June 8,
19 1999 issuance of the '987 Patent.

20 69. The applicants for the '861 Patent did not cite the Sibert article to the
21 Patent Office as prior art to any of claims 1-129 of the '861 Patent application (SN 08/805,804).

22 70. The applicants for the '861 Patent did not cite the WO 96/27155 (PCT)
23 publication to the Patent Office as prior art to any of claims 1-129 of the '861 Patent application
24 (SN 08/805,804).

25 71. The applicants for the '861 Patent did not cite the '987 Patent to the Patent
26 Office as prior art to any of claims 1-129 of the '861 Patent application (SN 08/805,804).

1 72. The applicants for the '861 Patent did not cite to the Patent Office as prior
2 art to any of claims 1-129 of the '861 Patent application (SN 08/805,804) any reference having
3 the same or substantially the same disclosure as the Sibert article.

4 73. The applicants for the '861 Patent did not cite to the Patent Office as prior
5 art to any of claims 1-129 of the '861 Patent application (SN 08/805,804) any reference having
6 the same or substantially the same disclosure as the WO 96/27155 (PCT) publication.

7 74. The applicants for the '861 Patent did not cite to the Patent Office as prior
8 art to any of claims 1-129 of the '861 Patent application (SN 08/805,804) any reference having
9 the same or substantially the same disclosure as the '987 Patent.

10 75. The Sibert article is not merely cumulative over any reference cited as prior
11 art during the prosecution of the '861 Patent application (SN 08/805,804).

12 76. The WO 96/27155 (PCT) publication is not merely cumulative over any
13 reference cited as prior art during the prosecution of the '861 Patent application (SN 08/805,804).

14 77. The '987 Patent is not merely cumulative over any reference cited as prior
15 art during the prosecution of the '861 Patent application (SN 08/805,804).

16 78. On information and belief, one or more of the '861 Patent applicants
17 believed, during pendency of claim 1 of the '861 Patent application (SN 08/805,804), that the
18 Sibert article disclosed an embodiment of claim 1 of the '861 Patent application (SN 08/805,804).

19 79. InterTrust contends that none of the '861 Patent applicants believed, during
20 pendency of claim 1 of the '861 Patent application (SN 08/805,804), that the Sibert article
21 discloses an embodiment of claim 1 of the '861 Patent application (SN 08/805,804).

22 80. On information and belief, one or more of the '861 Patent applicants
23 believed, during pendency of claim 1 of the '861 Patent application (SN 08/805,804), that the
24 WO 96/27155 (PCT) publication disclosed an embodiment of claim 1 of the '861 Patent
25 application (SN 08/805,804).

26 81. InterTrust contends that none of the '861 Patent applicants believed, during
27 pendency of claim 1 of the '861 Patent application (SN 08/805,804), that the WO 96/27155

1 (PCT) publication discloses an embodiment of claim 1 of the '861 Patent application (SN
2 08/805,804).

3 82. On information and belief, one or more of the '861 Patent applicants
4 believed, while the '861 Patent application (SN 08/805,804) was pending, that the Sibert article
5 was material to the patentability of claims 1-129 of the '861 Patent application (SN 08/805,804),
6 but, with deceptive intent, failed to disclose that reference as prior art to the Patent Office.

7 83. On information and belief, one or more of the '861 Patent applicants
8 believed, while the '861 Patent application (SN 08/805,804) was pending, that the WO 96/27155
9 (PCT) publication was material to the patentability of claims 1-129 of the '861 Patent application
10 (SN 08/805,804), but, with deceptive intent, failed to disclose that reference as prior art to the
11 Patent Office.

12 84. On information and belief, one or more of the '861 Patent applicants
13 believed, while the '861 Patent application (SN 08/805,804) was pending, that the '987 Patent
14 was material to the patentability of claims 29-129 of the '861 Patent application (SN 08/805,804),
15 but, with deceptive intent, failed to disclose that reference as prior art to the Patent Office.

16 85. The '861 Patent is unenforceable due to the inequitable conduct of the '861
17 Patent applicants and/or agents before the Patent and Trademark Office in connection with the
18 '861 Patent application (SN 08/805,804).

19 86. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
20 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
21 whether the claims of the '861 Patent are enforceable.

22 **COUNT XV - DECLARATORY JUDGMENT**
23 **OF UNENFORCEABILITY OF THE '900 PATENT**

24 87. Microsoft repeats and realleges paragraphs 1-5 and 46-47 of its
25 Counterclaims, as if fully restated here.

26 88. The application and issued claims of the '900 Patent were not and are not
27 entitled to the benefit of any application filing date prior to August 30, 1996, under 35 U.S.C. §
28 120 or otherwise.

1 89. The Sibert article is prior art to the application and issued claims of the
2 '900 Patent under 35 U.S.C. § 102(b).

3 90. The Sibert article was material to the patentability of application and issued
4 claims of the '900 Patent, including, for example, issued claims 86 and 182.

5 91. One or more of the '900 Patent applicants knew of the July 1995
6 publication of the Sibert article while the '900 Patent application (SN 08/706,206) was pending.

7 92. On information and belief, one or more of the attorneys who prosecuted or
8 assisted in the prosecution of the '900 Patent application (SN 08/706,206) knew of the July 1995
9 publication of the Sibert article while the '900 Patent application was pending.

10 93. The applicants for the '900 Patent did not cite the Sibert article to the
11 Patent Office as prior art to any claims of the '900 Patent application (SN 08/706,206).

12 94. The applicants for the '900 Patent did not cite to the Patent Office as prior
13 art to any claims of the '900 Patent application (SN 08/706,206) any reference having the same or
14 substantially the same disclosure as the Sibert article.

15 95. The Sibert article is not merely cumulative over any reference cited as prior
16 art during the prosecution of the '900 Patent application (SN 08/706,206).

17 96. On information and belief, one or more of the '900 Patent applicants
18 believed, during pendency of claim 1 of the '900 Patent application (SN 08/706,206), that the
19 Sibert article disclosed an embodiment of claim 1 of the '900 Patent application (SN 08/706,206).

20 97. On information and belief, one or more of the '900 Patent applicants
21 believed, while the '900 Patent application (SN 08/706,206) was pending, that the Sibert article
22 was material to the patentability of various claims of the '900 Patent application (SN 08/706,206),
23 but, with deceptive intent, failed to disclose that reference as prior art to the Patent Office.

24 98. The '900 Patent is unenforceable due to the inequitable conduct of the '900
25 Patent applicants and/or agents before the Patent and Trademark Office in connection with the
26 '900 Patent application (SN 08/706,206).

1 99. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
2 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
3 whether the claims of the '900 Patent are enforceable.

4 **COUNT XVI - DECLARATORY JUDGMENT**
5 **OF UNENFORCEABILITY OF THE '721 PATENT**

6 100. Microsoft repeats and realleges paragraphs 1-5 and 51 of its Counterclaims,
7 as if fully restated herein.

8 101. Claims 1-43 of the '721 Patent application (SN 08/689,754), and claims 1-
9 41 of the '721 Patent, were not and are not entitled to the benefit of any application filing date
10 prior to August 12, 1996, under 35 U.S.C. § 120 or otherwise.

11 102. The '987 Patent is prior art to claims 1-8, 10-29, and 31-43 of the '721
12 Patent application (SN 08/689,754).

13 103. The '987 Patent is prior art to claims 1-41 of the '721 Patent under 35
14 U.S.C. § 102(e).

15 104. The '987 Patent was material to the patentability of claims 1-8, 10-29, and
16 31-43 of the '721 Patent application (SN 08/689,754).

17 105. One or more of the '721 Patent applicants knew, while the '721 Patent
18 application (SN 08/689,754) was pending, of the '987 Patent.

19 106. On information and belief, one or more of the attorneys who prosecuted or
20 assisted in prosecuting the '721 Patent application (SN 08/689,754) knew, while that application
21 was pending, of the '987 Patent.

22 107. The applicants for the '721 Patent did not cite the '987 Patent to the Patent
23 Office as prior art to any of claims 1-43 of the '721 Patent application (SN 08/689,754).

24 108. The applicants for the '721 Patent did not cite to the Patent Office as prior
25 art to any of claims 1-43 of the '721 Patent application (SN 08/689,754) any reference having the
26 same or substantially the same disclosure as the '987 Patent.

1 109. The '987 Patent is not merely cumulative over any reference cited as prior
2 art during the prosecution of the '721 Patent application (SN 08/689,754).

3 110. On information and belief, one or more of the '721 Patent applicants
4 believed, while the '721 Patent application (SN 08/689,754) was pending, that the '987 Patent
5 was material to the patentability of one or more of claims 1-8, 10-29, and 31-43 of the '721 Patent
6 application (SN 08/689,754), but, with deceptive intent, failed to disclose that reference as prior
7 art to the Patent Office.

8 111. The applicants for the '721 Patent knew of, but did not cite to the Patent
9 Office as prior art to any of the claims of the '721 Patent application (SN 08/689,754), printed
10 publications regarding the use of digital signatures with Java.

11 112. On information and belief, one or more of the attorneys who prosecuted or
12 assisted in prosecuting the '721 Patent application knew, while that application was pending, of
13 printed publications describing the use of digital signatures with Java, but did not cite those
14 publications to the Patent Office.

15 113. On information and belief, one or more of the '721 Patent applicants knew
16 of General Magic's Telescript, (hereinafter "Telescript"), while the '721 Patent application (SN
17 08/689,754) was pending.

18 114. On information and belief, one or more of the attorneys who prosecuted or
19 assisted in prosecuting the '721 Patent application knew, while that application was pending, of
20 Telescript.

21 115. On information and belief, one or more of the '721 Patent applicants knew,
22 while the '721 Patent application (SN 08/689,754) was pending, of work done by Doug Tygar
23 and Bennett Yee regarding "Strongbox," (hereinafter "Strongbox").

24 116. On information and belief, one or more of the attorneys who prosecuted or
25 assisted in prosecuting the '721 Patent application knew, while that application was pending, of
26 work done by Doug Tygar and Bennett Yee regarding "Strongbox."

1 117. Strongbox, Telescript, and publications regarding the use of digital
2 signatures with Java are each material prior art to the '721 Patent.

3 118. On information and belief, InterTrust's failure to disclose Strongbox,
4 Telescript, and/or publications regarding the use of digital signatures with Java was made with
5 deceptive intent.

6 119. The '721 Patent is unenforceable due to the inequitable conduct of the '721
7 Patent applicants and/or agents before the Patent and Trademark Office in connection with the
8 '721 Patent application (SN 08/689,754).

9 120. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
10 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
11 whether the claims of the '721 Patent are enforceable.

12 **COUNT XVII - DECLARATORY JUDGMENT**
13 **OF UNENFORCEABILITY OF THE '181 PATENT**

14 121. Microsoft repeats and realleges paragraphs 1-5 and 46-51 of its
15 Counterclaims, as if fully restated herein.

16 122. The claims of the '181 Patent were not and are not entitled to the benefit of
17 any application filing date prior to November 6, 1997, under 35 U.S.C. § 120 or otherwise.

18 123. The '987 Patent is prior art to the claims of the '181 Patent.

19 124. The '987 Patent is prior art to each claim of the '181 Patent under 35
20 U.S.C. § 102(e).

21 125. The '987 Patent was material to the patentability of one or more claims of
22 the '181 Patent application (SN 08/965,185).

23 126. One or more of the '181 Patent applicants knew, while the '181 Patent
24 application (SN 08/965,185) was pending, of the '987 Patent.

25 127. On information and belief, one or more of the attorneys who prosecuted or
26 assisted in prosecuting the '181 Patent application knew, while that application was pending, of
27 the '987 Patent.

1 128. The applicants for the '181 Patent did not cite the '987 Patent to the Patent
2 Office as prior art to any of the claims of the '181 Patent application (SN 08/965,185).

3 129. The applicants for the '181 Patent did not cite to the Patent Office as prior
4 art to any of the claims of the '181 Patent application any reference having the same or
5 substantially the same disclosure as the '987 Patent.

6 130. The '987 Patent is not merely cumulative over any reference cited as prior
7 art during the prosecution of the '181 Patent application.

8 131. On information and belief, one or more of the '181 Patent applicants
9 believed, while the '181 Patent application (SN 08/965,185) was pending, that the '987 Patent
10 was material to the patentability of one or more of claims of the '181 Patent application (SN
11 08/689,754).

12 132. On information and belief, one or more of the '181 Patent applicants, with
13 deceptive intent, failed to disclose the '987 Patent as prior art to the Patent Office during the
14 prosecution of the '181 Patent application (SN 08/965,185).

15 133. The Sibert article is prior art to the application and issued claims of the
16 '181 Patent under 35 U.S.C. § 102(b).

17 134. The Sibert article was material to the patentability of one or more claims
18 sought by InterTrust in the course of the '181 Patent application.

19 135. The Sibert article was material to the patentability of one or more claims of
20 the '181 Patent.

21 136. One or more of the '181 Patent applicants knew of the July 1995
22 publication of the Sibert article while the '181 Patent application (SN 08/965,185) was pending.

23 137. On information and belief, one or more of the attorneys who prosecuted or
24 assisted in the prosecution of the '181 Patent application (SN 08/965,185) knew of the July 1995
25 publication of the Sibert article while the '181 Patent application was pending.

26 138. The applicants for the '181 Patent did not cite the Sibert article to the
27 Patent Office as prior art to any claims of the '181 Patent application (SN 08/965,185).

28

1 139. The applicants for the '181 Patent did not cite to the Patent Office as prior
2 art to any claims of the '181 Patent application (SN 08/965,185) any reference having the same or
3 substantially the same disclosure as the Sibert article.

4 140. The Sibert article is not merely cumulative over any reference cited as prior
5 art during the prosecution of the '181 Patent application (SN 08/965,185).

6 141. On information and belief, one or more of the '181 Patent applicants
7 believed, while the '181 Patent application (SN 08/965,185) was pending, that the Sibert article
8 was material to the patentability of one or more claims of the '181 Patent application (SN
9 08/965,185).

10 142. On information and belief, one or more of the '181 Patent applicants, with
11 deceptive intent, failed to disclose the Sibert article as prior art to the Patent Office during the
12 prosecution of the '181 Patent application (SN 08/965,185).

13 143. The WO 96/27155 (PCT) publication is prior art to one or more claims of
14 the '181 Patent application.

15 144. The WO 96/27155 (PCT) publication is prior art to the claims of the '181
16 Patent under 35 U.S.C. § 102(a).

17 145. The WO 96/27155 (PCT) publication is prior art to the claims of the '181
18 Patent under 35 U.S.C. § 102(b).

19 146. The WO 96/27155 (PCT) publication was material to the patentability of
20 claim 1 of the '181 Patent application (SN 08/965,185).

21 147. The WO 96/27155 (PCT) publication was material to the patentability of
22 one or more claims of the '181 Patent application (SN 08/965,185).

23 148. On information and belief, one or more of the '181 Patent applicants knew,
24 while the '181 Patent application (SN 08/965,185) was pending, of the September 1996
25 publication of the WO 96/27155 (PCT) publication.

26 149. One or more of the attorneys who prosecuted or assisted in prosecuting the
27 '181 Patent application (SN 08/965,185) knew, while that application was pending, of the
28 September 1996 publication of the WO 96/27155 (PCT) publication.

1 150. The applicants for the '181 Patent did not cite the WO 96/27155 (PCT)
2 publication to the Patent Office as prior art to any of the claims of the '181 Patent application (SN
3 08/965,185).

4 151. The applicants for the '181 Patent did not cite to the Patent Office as prior
5 art to any of the claims of the '181 Patent application (SN 08/965,185) any reference having the
6 same or substantially the same disclosure as the WO 96/27155 (PCT) publication.

7 152. On information and belief, one or more of the '181 Patent applicants
8 believed, while the '181 Patent application (SN 08/965,185) was pending, that the WO 96/27155
9 (PCT) publication was material to the patentability of one or more claims of the '181 Patent
10 application (SN 08/965,185).

11 153. On information and belief, one or more of the '181 Patent applicants, with
12 deceptive intent, failed to disclose the WO 96/27155 (PCT) publication as prior art to the Patent
13 Office during the prosecution of the '181 Patent application (SN 08/965,185).

14 154. The '900 Patent (U.S. Pat. No. 5,892,900) is prior art to the '181 Patent.

15 155. The '900 Patent is prior art to one or more claims of the '181 Patent under
16 35 U.S.C. § 102(e).

17 156. The '900 Patent was material to the patentability of one or more claims of
18 the '181 Patent application (SN 08/965,185).

19 157. One or more of the '181 Patent applicants knew, while the '181 Patent
20 application (SN 08/965,185) was pending, of the '900 Patent.

21 158. On information and belief, one or more of the attorneys who prosecuted or
22 assisted in prosecuting the '181 Patent application knew, while that application was pending, of
23 the '900 Patent.

24 159. The applicants for the '181 Patent did not cite the '900 Patent to the Patent
25 Office as prior art to any of the claims of the '181 Patent application (SN 08/965,185).

26 160. The applicants for the '181 Patent did not cite to the Patent Office as prior
27 art to any of the claims of the '181 Patent application any reference having the same or
28 substantially the same disclosure as the '900 Patent.

1 161. The '900 Patent is not merely cumulative over any reference cited as prior
2 art during the prosecution of the '181 Patent application.

3 162. On information and belief, one or more of the '181 Patent applicants
4 believed, while the '181 Patent application (SN 08/965,185) was pending, that the '900 Patent
5 was material to the patentability of one or more of claims of the '181 Patent application (SN
6 08/689,754).

7 163. On information and belief, one or more of the '181 Patent applicants, with
8 deceptive intent, failed to disclose the '900 Patent as prior art to the Patent Office during the
9 prosecution of the '181 Patent application (SN 08/965,185).

10 164. The '721 Patent (U.S. Pat. No. 6,157,721) is prior art to the '181 Patent.

11 165. The '721 Patent is prior art to one or more claims of the '181 Patent under
12 35 U.S.C. § 102(e).

13 166. The '721 Patent was material to the patentability of one or more claims of
14 the '181 Patent application (SN 08/965,185).

15 167. One or more of the '181 Patent applicants knew, while the '181 Patent
16 application (SN 08/965,185) was pending, of the '721 Patent.

17 168. On information and belief, one or more of the attorneys who prosecuted or
18 assisted in prosecuting the '181 Patent application knew, while that application was pending, of
19 the '721 Patent.

20 169. The applicants for the '181 Patent did not cite the '721 Patent to the Patent
21 Office as prior art to any of the claims of the '181 Patent application (SN 08/965,185).

22 170. The applicants for the '181 Patent did not cite to the Patent Office as prior
23 art to any of the claims of the '181 Patent application any reference having the same or
24 substantially the same disclosure as the '721 Patent.

25 171. The '721 Patent is not merely cumulative over any reference cited as prior
26 art during the prosecution of the '181 Patent application.

27 172. On information and belief, one or more of the '181 Patent applicants
28 believed, while the '181 Patent application (SN 08/965,185) was pending, that the '721 Patent

1 was material to the patentability of one or more of claims of the '181 Patent application (SN
2 08/689,754).

3 173. On information and belief, one or more of the '181 Patent applicants, with
4 deceptive intent, failed to disclose the '721 Patent as prior art to the Patent Office during the
5 prosecution of the '181 Patent application (SN 08/965,185).

6 174. The '181 Patent is unenforceable due to the inequitable conduct of the '181
7 Patent applicants and/or agents before the Patent and Trademark Office in connection with the
8 '181 Patent application (SN 08/965,185).

9 175. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
10 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
11 whether the claims of the '181 Patent are enforceable.

12 **COUNT XVIII - DECLARATORY JUDGMENT OF UNENFORCEABILITY**

13 176. Microsoft repeats and realleges the preceding paragraphs of its
14 Counterclaims, as if fully restated here.

15 177. The '891 Patent, the '912 Patent, the '683 Patent, the '193 Patent, the '861
16 Patent, the '900 Patent, the '721 Patent, the '019 Patent, the '876 Patent, the '181 Patent, and the
17 '402 Patent are referred to as the "Count XVIII Patents."

18 178. In prosecuting, marketing, and enforcing the Count XVIII Patents,
19 InterTrust has engaged in a pattern of obfuscation as to the scope of the patents, the prior art to
20 the patents, and the alleged "inventions" of the patents.

21 179. InterTrust has accused non-infringing products of infringement in this case.

22 180. InterTrust has accused non-secure products with infringement in this case.

23 181. InterTrust has buried Patent Office Examiners with a collection of more
24 than 400 references, many of which were not related to the particular claims in issue.

25 182. InterTrust has buried the Examiners with hundreds of thousands of pages
26 of redundant, verbose, unclear text, effectively prohibiting a real comparison of the alleged
27 "invention" to the prior art.

1 183. This pattern of intentional conduct constitutes an abuse of the patent
2 system, unclean hands, misuse and illegal extension of the patent right, rendering the Count
3 XVIII patents unenforceable, as well as invalid under 35 U.S.C. § 112.

4 184. InterTrust contends that it cannot readily determine whether or not it has
5 ever practiced the claims it asserts in this case, as InterTrust has interpreted those claims in its
6 PLR 3-1 Statements.

7 185. InterTrust contends that it cannot determine, with reasonable effort,
8 whether or not it has ever used its Commerce or Rights/System software to practice any of the
9 claims InterTrust asserts in this case, as InterTrust has interpreted those claims in its PLR 3-1
10 Statements.

11 186. As InterTrust has interpreted the claims it asserts in this case in its PLR 3-1
12 Statements, InterTrust does not know if it has ever practiced the subject matter of the patent
13 claims it asserts in this case.

14 187. No InterTrust officer has a non-privileged opinion or belief as to whether
15 InterTrust has ever practiced the subject matter of any of the patent claims it asserts in this case.

16 188. InterTrust contends that it cannot readily determine whether or not any
17 entity not a party to this case has ever practiced the claims that InterTrust asserts in this case, as
18 InterTrust has interpreted those claims in this case.

19 189. InterTrust contends that it cannot readily determine whether or not any of
20 the references cited in the patents it asserts in this case describes any invention that InterTrust
21 asserts is disclosed in any patent it asserts in this case.

22 190. No InterTrust officer has a non-privileged opinion or belief as to whether
23 Sony (whether Sony Corporation, Sony Corporation of America, and/or Sony Music
24 Entertainment Inc.), IBM, Adobe, AT&T, or Real Networks has ever practiced the subject matter
25 of any of the patent claims that InterTrust asserts in this case.

26 191. No InterTrust officer has a non-privileged opinion or belief as to whether
27 Sony (whether Sony Corporation, Sony Corporation of America, and/or Sony Music

1 Entertainment Inc.), IBM, Adobe, AT&T, or Real Networks has ever practiced a noninfringing
2 alternative to any of the patent claims that InterTrust asserts in this case.

3 192. No InterTrust officer has a non-privileged opinion or belief as to whether
4 the U.S. government has ever practiced the subject matter of any of the patent claims that
5 InterTrust asserts in this case.

6 193. InterTrust has never built the "Virtual Distribution Environment" referred
7 to at column 2 lines 22-35 of the '193 Patent.

8 194. No Microsoft product accused in this case is a "Virtual Distribution
9 Environment" as referred to at column 2 lines 22-35 of the '193 Patent.

10 195. As InterTrust's PLR 3-1 Statements have interpreted the '683 Patent claims
11 asserted in this case, one or more of those claims reads upon references that InterTrust cited to the
12 Patent Office during prosecution of the '683 Patent.

13 196. As InterTrust's PLR 3-1 Statements have interpreted the '683 Patent claims
14 asserted in this case, InterTrust cannot distinguish those claims from the subject matter disclosed
15 in the specification of U.S. Patent 5,715,403.

16 197. As InterTrust's PLR 3-1 Statements have interpreted the '683 Patent claims
17 asserted in this case, InterTrust cannot distinguish those claims from the subject matter disclosed
18 in the cited reference WO 93/01550.

19 198. As InterTrust's PLR 3-1 Statements have interpreted the '193 Patent claims
20 asserted in this case, one or more of those claims reads upon the subject matter disclosed in the
21 specification of U.S. Patent 5,638,443.

22 199. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,
23 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to
24 whether the claims of the '891 Patent, the '912 Patent, the '683 Patent, the '193 Patent, the '861
25 Patent, and the '900 Patent, the '721 Patent, the '019 Patent, the '876 Patent, the '181 Patent, and
26 the '402 Patent are enforceable.

**COUNT XIX - INFRINGEMENT
OF U.S. PATENT NO. 6,049,671**

200. Microsoft repeats and realleges paragraphs 2-3 of its Counterclaims, as if fully restated here.

201. This Court has exclusive subject matter jurisdiction over Microsoft's cause of action for patent infringement under Title 28, United States Code, Sections 1331 and 1338, and under the patent laws of the United States, Title 35 of the United States Code.

202. U.S. Patent No. 6,049,671 ("the '671 Patent") issued to Microsoft Corporation as the assignee of Benjamin W. Slivka and Jeffrey S. Webber on April 11, 2000.

203. A true copy of the '671 Patent is attached as Exhibit C to Microsoft's counterclaims filed in response to InterTrust's Second Amended Complaint, and is incorporated herein by reference.

204. Microsoft owns all right, title and interest in the '671 Patent.

205. InterTrust has had actual notice of the '671 Patent.

206. InterTrust has infringed one or more claims of the '671 Patent, in violation of at least 35 U.S.C. § 271(a, b, c).

207. InterTrust's infringement of the '671 Patent has caused and will continue to cause Microsoft damage, including irreparable harm for which it has no adequate remedy at law.

**COUNT XX - INFRINGEMENT
OF U.S. PATENT NO. 6,256,668**

208. Microsoft repeats and realleges paragraphs 2-3 and 201 of its Counterclaims, as if fully restated here.

209. U.S. Patent No. 6,256,668 B1 ("the '668 Patent") issued to Microsoft Corporation as the assignee of Benjamin W. Slivka and Jeffrey S. Webber on July 3, 2001.

210. A true copy of the '668 Patent is attached as Exhibit D to Microsoft's counterclaims filed in response to InterTrust's Second Amended Complaint, and is incorporated herein by reference.

211. Microsoft owns all right, title and interest in the '668 Patent.

1 212. InterTrust has had actual notice of the '668 Patent.

2 213. InterTrust has infringed one or more claims of the '668 Patent, in violation
3 of at least 35 U.S.C. § 271(a, b, c).

4 214. InterTrust's infringement of the '668 Patent has caused and will continue to
5 cause Microsoft damage, including irreparable harm for which it has no adequate remedy at law.

6 **PRAYER FOR RELIEF**

7 WHEREFORE, Microsoft prays for the following relief:

8 A. The Court enter judgment against InterTrust, and dismiss with prejudice,
9 any and all claims of the Fourth Amended Complaint;

10 B. The Court enter judgment declaring that Microsoft has not infringed,
11 contributed to infringement of, or induced infringement of the '683 Patent;

12 C. The Court enter judgment declaring that Microsoft has not infringed,
13 contributed to infringement of, or induced infringement of the '193 Patent;

14 D. The Court enter judgment declaring that Microsoft has not infringed,
15 contributed to infringement of, or induced infringement of the '504 Patent;

16 E. The Court enter judgment declaring that Microsoft has not infringed,
17 contributed to infringement of, or induced infringement of the '861 Patent;

18 F. The Court enter judgment declaring that Microsoft has not infringed,
19 contributed to infringement of, or induced infringement of the '900 Patent;

20 G. The Court enter judgment declaring that Microsoft has not infringed,
21 contributed to infringement of, or induced infringement of the '891 Patent;

22 H. The Court enter judgment declaring that Microsoft has not infringed,
23 contributed to infringement of, or induced infringement of the '912 Patent;

24 I. The Court enter judgment declaring that Microsoft has not infringed,
25 contributed to infringement of, or induced infringement of the '721 Patent;

26 J. The Court enter judgment declaring that Microsoft has not infringed,
27 contributed to infringement of, or induced infringement of the '019 Patent;

28

1 K. The Court enter judgment declaring that Microsoft has not infringed,
2 contributed to infringement of, or induced infringement of the '876 Patent;

3 L. The Court enter judgment declaring that Microsoft has not infringed,
4 contributed to infringement of, or induced infringement of the '181 Patent;

5 M. The Court enter judgment declaring that Microsoft has not infringed,
6 contributed to infringement of, or induced infringement of the '402 Patent;

7 N. The Court enter judgment declaring that the '683 Patent is invalid;

8 O. The Court enter judgment declaring that the '193 Patent is invalid;

9 P. The Court enter judgment declaring that the '504 Patent is invalid;

10 Q. The Court enter judgment declaring that the '861 Patent is invalid;

11 R. The Court enter judgment declaring that the '900 Patent is invalid;

12 S. The Court enter judgment declaring that the '891 Patent is invalid;

13 T. The Court enter judgment declaring that the '912 Patent is invalid;

14 U. The Court enter judgment declaring that the '721 Patent is invalid;

15 V. The Court enter judgment declaring that the '019 Patent is invalid;

16 W. The Court enter judgment declaring that the '876 Patent is invalid;

17 X. The Court enter judgment declaring that the '181 Patent is invalid;

18 Y. The Court enter judgment declaring that the '402 Patent is invalid;

19 Z. The Court enter judgment declaring that the '861 Patent, the '900 Patent,
20 the '721 Patent, and the '181 Patent are each unenforceable due to inequitable conduct;

21 AA. The Court enter judgment declaring that each of the '891 Patent, the '912
22 Patent, the '683 Patent, the '193 Patent, the '861 Patent, the '900 Patent, the '721 Patent, the '019
23 Patent, the '876 Patent, the '181 Patent, and the '402 Patent is unenforceable due to an abuse of
24 the patent system, unclean hands, and misuse and illegal extension of the patent right;

25 BB. The Court enter judgment that InterTrust has infringed the '671 Patent;

26 CC. The Court enter judgment that InterTrust has infringed the '668 Patent;

1 DD. The Court enter a permanent injunction prohibiting InterTrust, its officers,
2 agents, servants, employees, and all persons in active concert or participation with any of them
3 from infringing the '671 and '668 Patents;

4 EE. The Court award damages and attorney fees against InterTrust pursuant to
5 the provisions of 35 U.S.C §§ 284 and 285.

6 FF. The Court award to Microsoft pre-judgment interest and the costs of this
7 action.

8 GG. The Court award to Microsoft its reasonable costs and attorneys' fees; and

9 HH. The Court grant to Microsoft such other and further relief as may be
10 deemed just and appropriate.

11 **JURY DEMAND**

12 Pursuant to Fed. R. Civ. P. 38(b), Defendant Microsoft Corporation demands a
13 trial by jury.

14 DATED: November 7, 2002

15 By: 

16 WILLIAM L. ANTHONY

17 ERIC L. WESENBERG

18 SAM O'ROURKE

19 ORRICK HERRINGTON & SUTCLIFFE, LLP

20 1000 Marsh Road

21 Menlo Park, CA 94025

22 Telephone: 650-614-7400

23 STEVEN ALEXANDER

24 KRISTIN L. CLEVELAND

25 JAMES E. GERINGER

26 JOHN D. VANDENBERG

27 KLARQUIST SPARKMAN, LLP

28 One World Trade Center, Suite 1600

121 S.W. Salmon Street

Portland, OR 97204

Telephone: (503) 226-7391

Attorneys for Defendant
Microsoft Corporation

Of Counsel:

T. Andrew Culbert, Esq.

MICROSOFT CORPORATION

One Microsoft Way, Building 8

Redmond, WA 98052-6399

Phone: 425-882-8080